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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,120	11/21/2003	Michael R. McGovern	85524CEB	1800

7590

01/04/2006

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EXAMINER
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KJM, SANG K .

ART UNIT	PAPER NUMBER
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3654

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/719,120	<b>Applicant(s)</b> MCGOVERN ET AL.	
	<b>Examiner</b> SANG KIM	<b>Art Unit</b> 3654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on RCE 10/31/05.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/25/05</u> . | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/05 has been entered.

***Terminal Disclaimer***

The terminal disclaimer filed on 9/6/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application No. 10/719578 and 10/719444 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement and the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the

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time the application was filed, had possession of the claimed invention. Further, the specification does not adequately disclose the subject matter in a way to enable one skilled in the art to make or used the invention. In claim 1, the phrase, "wherein x1 is greater than x2," is new matter and lacks enablement. The specification specifically states at page 3, lines 25-27, that x1 is less than x2.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akao et al., U.S. Patent No. 4989802, in view of Sasaki et al., U.S. Patent No. 4576344.

With respect to claim 1, Akao '802 shows a generally cylindrical single support structure (1) having an outer web wrapping surface for receiving at least one convolution of a web, the web material itself has a static coefficient of friction x2, the outer surface is made rough which would provide a static coefficient of friction x1 with respect to the web, see column 3, lines 39-46.

Akao '802 does not explicitly explain the web wrapping surface having a surface texture less than .5 microns to produce a static coefficient of friction x1, wherein x1 is greater than x2.

Sasaki '344 explains the surface roughness of the film ranging from .001 to .05 microns, which inherently has a static coefficient of friction x2, see abstract.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the apparatus of Akao '802 with a surface texture less than .5 microns to wind the web as taught by Sasaki '344, since the surface needs to have some sort of friction to engage the web to the core, but at the same time not too much of friction can be applied to the surface of the core in order to prevent damage to the web during winding.

With respect to claims 2-5, as advanced above, Akao '802 teaches the core may be any thermoplastic resin or contain other known additives, see column 4, lines 28-31, and column 8, lines 13-17.

Akao in view of Sasaki does not show a certain type of plastic, such as, amorphous thermoplastic resins, semi-crystalline thermoplastic resins, polycarbonate, silicone polycarbonate copolymers, polybutylene-terephthalate and polybutylene-terephthalate, but does teach other plastic material resins or contain other known additives.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the apparatus of Akao in view of Sasaki with amorphous thermoplastic resins, semi-crystalline thermoplastic resins, polycarbonate, silicone polycarbonate copolymers, polybutylene-terephthalate and polybutylene-terephthalate, since other known additives can be used to make the core. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the

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basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

With respect to claims 6-10, as advanced above, Akao '802 teaches the bending elastic modulus, the Izod impact strength and the Rockwell hardness (i.e., more than 90 R), see column 4, lines 62-68, and column 5, lines 1-25.

Akao in view of Sasaki does not show a certain tensile strength and flexural strength of the material to ensure that the material can handle the web to the highest quality.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the apparatus of Akao in view of Sasaki with a certain tensile strength and flexural strength since any plastic material has a characteristics of a tensile strength, flexural strength, and Rockwell R hardness during testing; thus other known additives can be used as a reinforcing agent. Furthermore, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

### ***Response to Arguments***

Claims 1 and 6 have been amended.

Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection as set forth above.

The added recitation that  $x_1$  is greater than  $x_2$  necessitated the new grounds of rejection.

***Conclusion***

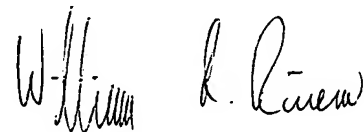
Any inquiry concerning this communication or earlier communications from the examiner should be directed to SANG KIM whose telephone number is 571-272-6947. The examiner can normally be reached Monday through Friday from 8:00 A.M. to 5:30 P.M. alternating Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki, can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SK

12/14/05

Handwritten signature of William A. Rivera in black ink.

**WILLIAM A. RIVERA  
PRIMARY EXAMINER**